

REMARKS

With entry of the claims here presented the pending claims would be claims 13-26.

Interview

Examiner Umez-Eronini is thanked for the courtesies extended by her to applicants' representative, David R. Murphy, at the personal interview held at the United States Patent and Trademark Office (PTO) on March 8, 2005. In full compliance with MPEP 713.04, the following remarks incorporate the substance of the arguments advanced at that interview.

At the interview three new claims arbitrarily called claims 125-127 were discussed with the Examiner. By the present amendment claim 13 has been amended to conform to claim 125, while new claims 25 and 26 correspond respectively to claims 126 and 127 as discussed in the Interview with the Examiner.

At the interview the showings made in a certain document entitled "DECLARATION UNDER 37 CFR 1.132" SIGNED BY THE INVENTOR Fujii on February 15, 2005, (the Fujii Declaration) were discussed. It was pointed out to the Examiner that the symbols "S", "A", "B", and "C" appearing in the Fujii Declaration in the last column of Table B on page 5, are defined in the specification as filed on

page 44 beginning at the top of the page. The Fujii Declaration is being filed concurrently herewith.

Support

Support for the amendments to claim 13 and for newly added claims 25 and 26 can be found in the specification as filed on page 22 at lines 1-7.

Issues Under 35 USC § 102

The rejection of claims 13, 14, 15 and 20-23 in paragraph 2 on page 2 of the last Office Action as anticipated by US 6,015,506 (Streinz) is traversed but has been rendered moot by the present amendment. All pending claims now include the following phrase:

wherein said abrasive is α -alumina and the amount of the intermediate alumina is from 1 to 100 parts by weight based on 100 parts by weight of α -alumina.

and thus require the presence of α -alumina in a certain ratio. Streinz does not disclose this. The Examiner is thanked for the statement in the Interview Summary dated 08 March 2005 namely that the "'new claims' would overcome the art rejection". By "new claims" the Examiner is referring to claims 125-127 on Exhibit A.

The rejection of claims 17-19 and 24 in paragraph 3 on page 5 of the last Office Action as anticipated by US 5,783,489 (Kaufman) is traversed but has been rendered moot by the present amendments to the claims. Kaufman does not disclose the presence of α -alumina in the ratio as defined in the claims as now amended.

Issues Under 35 USC § 103

The rejection of selected claims in paragraphs 4-6 as obvious over Streinz and certain other references is traversed but has been rendered moot by the present amendments to the claims.

Further prosecution

The interview summary states that the "new claims . . . would not be entered because they raise new issues". It is agreed that they raise new issues. Accordingly the Examiner is advised that it is the intention of the undersigned to timely file a request for continued examination (RCE). Since it is undisputed that examination of the "new claims", which were claims 125-127 as discussed during the interview and are now pending as amended claim 13 and new claims 25 and 26, raise new issues, it would not be appropriate for any first action on the merits to be a "final" rejection. If there be a rejection, it should be non-final in order to afford applicants an opportunity to further amend as a matter of right.


CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
John W. Bailey, #32,881

JWB/DRM:drm
1422-0472P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Enclosure: "DECLARATION UNDER 37 CFR 1.132" of Mr. Fujii